

## REMARKS

Reconsideration of this application is respectfully requested in light of the above amendments and the following remarks. After the amendments detailed above, claims 1-5, 7-12 and 14-34 are pending in this application. In particular, claims 1, 9, 15, 19, 26 and 31 have been amended. Claims 6 and 13 remain canceled. No new claims are added. Applicant asserts that the amended claims are fully supported by the disclosure of the application as filed, and as such, do not introduce new matter. The status of all the pending claims is reflected in the above listing.

### I. 35 U.S.C. § 102

#### Claims 1, 4, 8, 9, 15 and 17

Claims 1, 4, 8, 9, 15 and 17 stand rejected under 35 U.S.C. §102(b) as being anticipated by Vaagenes (U.S. Patent No. 4,093,973). These rejections are moot as claims 1, 9 and 15 have been amended.

To anticipate a claim, the cited reference must disclose each and every limitation recited in the subject claim. "Anticipation requires the disclosure in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). As set forth below, Vaagenes fails to disclose, expressly or inherently, at least one element recited in each of the amended independent claims 1, 9 and 15.

As illustrated in the figures and described in the specification, a lighting device 100 includes a button 160 for activating a light source contained within a housing 110 of the lighting device 100 (pages 3-4, paragraphs [0015] and [0017], and figures 1 and 2), the button 160 for activating the light source extending from the bottom of the housing 110 and can make contact with a user's thumb or finger when the user is wearing the lighting device 100 (figure 1). The light source can be activated by applying purposeful pressure to the

button 160 and turned off by releasing the pressure (page 1, paragraph [0003]). In other words, the light source can be intermittently activated, i.e., the light source is not activated when the user is wearing the lighting device 100 if no pressure is applied to the button 160.

Accordingly, the present claims are patentably distinct as written, and the rejection of these claims under Section 102 must be withdrawn. Specifically, claims 1 and 9 have been amended to further recite "... without activating said light source" and claim 15 has been amended to further recite "... without activating the one or more light sources."

Vaagenes, in contrast, fails to disclose a light source that can be intermittently activated. The purpose in Vaagenes is to provide a unitary jewelry having a switch built into the jewelry such that a light source is automatically activated when worn (col. 1, lines 15-31). The switch in Vaagenes is mounted such that when a ring is placed upon the finger of the wearer, the switch is automatically depressed causing the light source to be illuminated (col. 2, lines 31-54). Accordingly, Vaagenes fails to disclose, explicitly or inherently, at least one element recited in each of amended independent claims 1, 9 and 15.

Since Vaagenes fails to expressly or inherently disclose each element in amended independent claims 1 and 15, and since claims 4, 8 and 17 depend from and further limit claims 1 and 15, the rejection of these claims is also overcome. Therefore, claims 1, 4, 8, 9, 15 and 17 are patentably distinct as written, and the rejection of these claims under Section 102 should accordingly be withdrawn.

## **II. 35 U.S.C. § 103**

### **Claims 2, 3, 5, 7, 10-12, 14, 16 and 18-34**

Claims 2, 3, 7, 10, 11, 14, 16 and 18 stand rejected under U.S.C. § 103(a) as being unpatentable over Vaagenes, claims 5 and 12 over Vaagenes in view of Dion (U.S. Patent No. 5,934,784), and claims 19-34 over Gong-Hwa (U.S. Patent No. 5,622,062) in view of Vaagenes. These rejections are moot since Vaagenes does not disclose or teach all of the elements recited in independent claims 1, 9 and 15 as discussed above. See discussion supra. Furthermore, there is no motivation to combine Vaagenes with Dion or Gong-Hwa

with Vaagenes because the objective in Vaagenes is to provide a jewelry that is automatically activated upon a user wearing the jewelry.

With regards to claims 2, 3, 7, 10, 11, 14, 16 and 18, Vaagenes does not disclose or teach all of the elements recited in independent claims 1, 9 and 15 as discussed above. See discussion supra. Therefore, applicant respectfully asserts that these claims are not obvious in view of Vaagenes, since these dependent claims depend from and further limit independent claims 1, 9 and 15. The arguments made above with respect to independent claims 1, 9 and 15 regarding the applicability of the Vaagenes reference apply with equal force here. See discussion supra. For at least these reasons, Vaagenes does not teach or suggest all of the elements of independent claims 1, 9 and 15, from which the rejected dependent claims 2, 3, 7, 10, 11, 14, 16 and 18 depend. Thus, Applicant respectfully requests that the Examiner withdraw the Section 103 rejection.

With regards to claims 5, 12 and 19-34, the combination of Vaagenes with Dion or Gong-Hwa would render the invention unsatisfactory for its intended purpose because in Vaagenes there is no teaching or motivation, explicit or inherent, for producing jewelry having a light source capable of being intermittently activated upon a user wearing the jewelry. See discussion supra. Thus, applicant respectfully requests that the Examiner withdraw the Section 103 rejection to claims 5, 12 and 19-34 because there is no incentive or motivation to combine Vaagenes with Dion or Gong-Hwa with Vaagenes, and furthermore because such a combination would render the invention unsatisfactory for its intended purpose.

For at these reasons, the Examiners burden of factually supporting a *prima facie* case of obviousness has not been met, and the rejection under Section 103 of claims 2, 3, 5, 7, 10-12, 14, 16 and 18-34 should be withdrawn.

### III. Conclusion

It is respectfully submitted that the application is now in condition for allowance and, accordingly, reconsideration and allowance are respectfully requested. Should any

Appl. No. 10/648,655  
Amdt. dated August 29, 2006  
Reply to Final Office Action of July 13, 2006

questions remain regarding the allowability of the application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

Greenberg Traurig  
3773 Howard Hughes Pkwy.  
Suite 500 North  
Las Vegas, Nevada 89109

Telephone : 702-792-3773  
Facsimile : 702 792-9002

Respectfully submitted,

By: 

Rob L. Phillips  
Registration No. 40,305

Date: August 29, 2006

G:\APatent\Houdinis\PTO.RCE2.Amend.doc